

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHEL SAFARS, FABRICE FRACHON,
PIERRE SILVESTRE DE SACY, THIERRY VERRECCHIA, and
PHILIPPE LELONG

Appeal 2007-0273
Application 09/132,327
Technology Center 2100

Decided: March 20, 2007

Before MAHSHID D. SAADAT, ALLEN R. MACDONALD, and JEAN R.
HOMERE, *Administrative Patent Judges*.

MACDONALD, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134 from the Examiner's rejection of claims 62-78, the only claims pending in this application. We have jurisdiction under 35 U.S.C. § 6(b).

STATEMENT OF THE CASE

Appellants invented a method for organizing electronic documents in an electronic book using page applets known as “pagelets.” Pagelets are computer programs that perform certain functions with respect to the electronic book including, among other things, altering the structure and arrangement of the electronic book. *See generally* Specification 41:5-47:27. Claim 75 is illustrative:

75. A method for organizing and using electronic documents, the method comprising the steps of:

organizing a multiplicity of electronic documents originating from a plurality of sources and supplied in various forms using a book metaphor so that the documents are arranged as pages in chapters in an electronic book;

adding to the electronic book further pages that have a common architecture and that are each usable in other electronic books (the further pages are denoted pagelets), the pagelets being computer programs that perform different specific functions related to the electronic documents in the electronic books in which the pagelets are operated, the specific functions accessing and altering a structure of the electronic book and being distinct from functions accessing contents referenced by the pages of the electronic book; and

performing the specific functions of one of the pagelets in the electronic book.

The Examiner relies on the following prior art references to show unpatentability:

Fein	US 5,924,108	July 13, 1999 (filed Mar. 29, 1996)
Sidana	US 6,081,829	June 27, 2000 (filed Jan. 31, 1996)
Gish	US 6,233,620 B1	May 15, 2001 (filed July 2, 1996)
Weinberg	US 6,237,006 B1	May 22, 2001 (filed Nov. 10, 1999) ¹
Robertson	US 6,486,895 B1	Nov. 26, 2002 (filed Sept. 8, 1995)

Laura Lemay & Michael Moncur, *JavaScript*, Sams.net Publishing, 1st ed., 1996 (“JavaScript”).

The Examiner’s rejections are as follows:

1. Claim 75 is rejected under 35 U.S.C. § 103(a) as unpatentable over Robertson in view of Sidana and further in view of JavaScript.
2. Claims 76-78 are rejected under 35 U.S.C. § 103(a) as unpatentable over Robertson in view of Sidana, JavaScript, and further in view of Gish.
3. Claims 62-74 are rejected under 35 U.S.C. § 103(a) as unpatentable over Robertson in view of Sidana, JavaScript, Gish, Weinberg, and further in view of Fein.

Rather than repeat the arguments of Appellants or the Examiner, we refer to the Brief and the Answer for their respective details. In this decision, we have considered only those arguments actually made by Appellants. Arguments which Appellants could have made but chose not to

¹ Continuation of application No. 08/843,265, filed Apr. 11, 1997, now U.S. Pat. 6,144,962.

make in the Brief have not been considered and are deemed to be waived.
See 37 C.F.R. § 41.37(c)(1)(vii) (2004).

OPINION

We first consider the Examiner's rejection of claim 75 under 35 U.S.C. § 103(a) as unpatentable over Robertson in view of Sidana and further in view of JavaScript. In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). If that burden is met, the burden then shifts to the Appellants to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. *See In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

The Examiner's rejection essentially finds that Robertson teaches organizing electronic documents into an electronic book with every claimed feature except for (1) arranging the documents as pages in chapters; (2) the pagelets comprising computer programs that perform different specific functions related to the electronic documents as claimed, including accessing and altering the structure of the electronic book and being distinct from functions access contents referenced by the pages of the electronic book; and (3) the pagelets being each useable in other electronic books as claimed (Answer 4).

Regarding difference (1), the Examiner contends that since Robertson organizes information in a book metaphor, it would have been obvious to the skilled artisan to have divided the electronic book into chapters to enable the user to organize the documents (Answer 3-4).

Regarding difference (2), the Examiner cites Sidana as teaching editing, adding, and deleting annotations to web pages using functions or buttons located in web pages. The Examiner concludes that, in view of Sidana, and further noting the teachings of JavaScript, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the prior art to easily annotate web pages, such as those in Robertson's electronic book (Answer 4).

Regarding difference (3), the Examiner contends that it would have been obvious to the skilled artisan at the time of the invention to allow pages to be used in other books since Robertson teaches (a) transferring the electronic book for use by others, and (b) converting web pages into interchangeable and rearrangeable objects (Answer 4-5).

Appellants argue that the prior art does not disclose or suggest pagelets that alter the structure of the electronic book as claimed. According to Appellants, adding annotations to a page in Robertson's electronic book would not alter the structure of the electronic book, but would merely add content to particular pages of the book. Simply put, Appellants contend that adding content to pages of an electronic book is not altering the structure of the electronic book itself (Br. 5-7). The Examiner argues that Sidana teaches altering the HTML structure of the web page by adding annotation buttons and an annotation section (Answer 8-9).

We will sustain the Examiner's rejection of independent claim 75. In our view, adding content to Robertson's electronic book in the manner suggested by Sidana alters the book's structure, at least broadly. Appellants' arguments to the contrary are simply not commensurate with the scope of the claim.

Sidana provides a software program (a "redirector") that allows a user to store and display custom information (e.g., user annotations) in conjunction with web documents. After receiving a request to view a particular web document, the redirector modifies the HTML of the requested document to include (1) any previously-added annotations, and (2) various user-input forms (e.g., buttons, text boxes, etc.) displayable by the browser. The redirector then sends this "augmented HTML" to the user's browser to display the specified web document along with the input forms and annotations (Sidana, col. 1, l. 55 – col. 2, l. 33; col. 6, ll. 49-67; col. 7, ll. 18-42).

Significantly, this augmented HTML not only adds content in the form of annotations, but also *functionality* in the form of user-input forms (buttons, text boxes, etc.). In our view, adding web pages with such enhanced content and functionality as suggested by Sidana (i.e., pages capable of retrieving augmented HTML) to Robertson's electronic book of web pages would alter the book's structure as claimed, at least in terms of its content and functionality.

For example, if the web pages in Robertson's electronic book consisted solely of text (i.e., pure text-based content with no added functionality), adding pages with enhanced functionality and content as suggested by Sidana would effectively transform the structure of

Robertson's electronic book from static, text-only content to dynamic, interactive content.

Appellants' contention that adding annotations to web pages would ostensibly not change the web pages themselves is unavailing. Although Sidana states that the *original* document is not modified as Appellants indicate (Sidana, col. 2, ll. 36-37; emphasis added), the redirector effectively creates a new document comprising augmented HTML and sends it to the user's browser as noted above.² In our view, augmenting the underlying HTML of an electronic book's individual web pages in this manner (i.e., by adding annotation buttons and an annotation section) fully meets "altering the structure of the book" as claimed given the scope and breadth of the limitation.

We also find the Examiner's reliance on JavaScript for the reasons noted in the rejection is reasonable, and indeed, not in dispute. We add that implementing enhanced, interactive functionality in web pages via JavaScript would have been well within the level of the skilled artisan – an electrical engineer with several years of related industry experience.

For at least these reasons, the Examiner's rejection of independent claim 75 based on the collective teachings of Robertson, Sidana, and JavaScript will be sustained.

We next consider the Examiner's rejection of claims 76-78 under 35 U.S.C. § 103(a) as unpatentable over Robertson in view of Sidana, JavaScript, and further in view of Gish. Regarding independent claim 76, we find that (1) the Examiner has established at least a *prima facie* case of obviousness on Pages 5 and 6 of the Answer, and (2) Appellants have not

² See Page 6, *supra*, of this opinion.

persuasively rebutted the Examiner's prima facie case, but merely noted that the addition of Gish fails to cure the deficiencies of the other cited references noted above (Br. 7). For at least the reasons previously discussed,³ the Examiner's prima facie case of obviousness has not been rebutted. Accordingly, the rejection of independent claim 76 is sustained.

Regarding claim 77, the Examiner admits that Robertson does not disclose adding the selected pagelet as a page to a catalog. The Examiner, however, argues that it would have been obvious to one of ordinary skill in the art to add the selected pagelets to a catalog or website as claimed since Robertson teaches (a) transferring the electronic book for use by others, and (b) converting web pages into interchangeable and rearrangeable objects (Answer 7).

Appellants argue that the prior art does not disclose (1) adding a selected pagelet to a catalog, and (2) copying the selected pagelet to the electronic book. Appellants note that the Examiner's interpretation that the electronic book constitutes the claimed catalog is incorrect since the book and the catalog must be different (Br. 8). The Examiner responds that the catalog as claimed is a website with additional pages that would serve as a source for other users to copy interchangeable pages added to the website for creating electronic books (Answer 9).

We will sustain the Examiner's rejection of claim 77. Significantly, Robertson assembles the pages of the electronic book by generating an ordered list of pages. To this end, Robertson retrieves, stores, and orders

³ See Pages 6-7, *supra*, of this opinion. Our analysis is equally applicable to the commensurate limitation of claim 76 reciting, in pertinent part, "altering the *arrangement* of the electronic book" in lieu of altering its *structure* recited in claim 75.

each page to retain page relationships. Such ordering allows related pages to be grouped sequentially within the electronic book (Robertson, col. 7, ll. 13-35). Each web page is then converted into a page object representing specific pages in the electronic book (Robertson, col. 7, l. 65 – col. 8, l. 2).

In our view, Robertson's retrieving, storing, and ordering pages reasonably corresponds to selecting and adding pages to a catalog giving the term its broadest reasonable interpretation. We see no reason why pages with annotations as taught by Sidana could not be so cataloged and copied into Robertson's electronic book as claimed. The Examiner's rejection of claim 77 is therefore sustained.

Regarding claim 78, Appellants argue that the prior art does not disclose adding to the electronic book one or more pagelet means for altering the arrangement of the electronic book as claimed. Appellants note that the claim invokes 35 U.S.C. § 112, sixth paragraph and that the functions or buttons in Sidana are not equivalent to the pagelet means for altering the arrangement of the electronic book disclosed on Pages 41-47 of the specification (Br. 8-9). The Examiner responds that Sidana's buttons that are added to a web page augment or change the arrangement of HTML source code elements in the web page (Answer 10).

We will sustain the Examiner's rejection of claim 78. Means-plus-function claim language must be construed in accordance with 35 U.S.C. § 112, ¶ 6 by "look[ing] to the specification and interpret[ing] that language in light of the corresponding structure, material, or acts described therein, and equivalents thereof, to the extent that the specification provides such disclosure." *In re Donaldson Co., Inc.*, 16 F.3d 1189, 1193, 29 USPQ2d 1845, 1848 (Fed. Cir. 1994).

Appellants' specification describes pagelets as "system pages." These pages that allow the user to influence the structure of the book to (1) consult it (index, table of contents, etc.), or (2) alter it (e.g., reorganize the table of contents). To this end, pagelets are reusable software components with standardized independent interfaces and may be scripted. These interfaces make it possible to go to a given page, insert pages into the book, know which chapter the user is in, reorganize the book, access the content of other pages of the book, etc. (Specification 41:5-42:1).

The specification further lists exemplary pagelets implementing a variety of functions including (1) generating a summary from document(s) dealing with similar subjects using linguistic analysis; (2) providing a search engine; (3) completely reorganizing the contents of a chapter or book by grading its pages by topic and subtopic; (4) generating real-time information on frequency and time of use, quantity of information stored, etc. using statistical analysis; (5) assisting the user in making decisions by studying their activities pertaining to certain documents or books (Specification 43:7-44:29).

When considering whether a prior art element is equivalent to a claimed element, factors we consider include whether: (1) the prior art element performs the identical function specified in the claim in substantially the same way, and produces substantially the same results as the corresponding element disclosed in the specification, *Kemco Sales, Inc. v. Control Papers Co.*, 208 F.3d 1352, 54 USPQ2d 1308 (Fed. Cir. 2000); (2) the skilled artisan would have recognized the interchangeability of the prior art element for the corresponding element disclosed in the specification, *Caterpillar Inc. v. Deere & Co.*, 224 F.3d 1374, 56 USPQ2d

1305 (Fed. Cir. 2000); (3) there are insubstantial differences between the prior art element and the corresponding element disclosed in the specification, *IMS Technology, Inc. v. Haas Automation, Inc.*, 206 F.3d 1422, 1436, 54 USPQ2d 1129, 1138 (Fed. Cir. 2000); and (4) the prior art element is a structural equivalent of the corresponding element disclosed in the specification, *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990); *see also* MPEP § 2183.

In our view, Sidana's augmented HTML that adds functionality to the web pages of Robertson's electronic book in the form of user-input forms (buttons, text boxes, etc.) to insert, edit, and delete annotations is equivalent to the disclosed pagelet means for altering the arrangement of the electronic book as claimed. The collective teachings of the prior art perform the same function (enhancing the user's ability to consult the electronic book) in substantially the same way (using pages to impart such functionality) to produce substantially the same result (altering the arrangement of the electronic book) as the corresponding pagelet means disclosed in the specification.

We reach this conclusion particularly noting that Appellants' specification does not provide an exclusive list of tools that influence the book's structure for consultation, but rather provides an open-ended list that includes the term "etc." – a term suggesting a wide variety of consultation tools. *See* Specification 41:5-8. In our view, the ability to add annotations to an electronic book via added pages as suggested in the prior art is a consultation tool that is commensurate with the open-ended list of consultation tools noted in the specification.

For at least these reasons, we will sustain the Examiner's rejection of independent claim 78.

We next consider the Examiner's rejection of claims 62-74 under 35 U.S.C. § 103(a) as unpatentable over Robertson in view of Sidana, JavaScript, Gish, Weinberg, and further in view of Fein. We find that the Examiner has established at least a prima facie case of obviousness of those claims that Appellants have not persuasively rebutted. Specifically, the Examiner has (1) pointed out the teachings of Robertson, Sidana, JavaScript, and Gish, (2) noted the perceived differences between those references and the claimed invention, and (3) reasonably indicated how and why the references would have been modified by the teachings of Weinberg and Fein to arrive at the claimed invention (Answer 7-8). Once the Examiner has satisfied the burden of presenting a prima facie case of obviousness, the burden then shifts to Appellants to present evidence or arguments that persuasively rebut the Examiner's prima facie case. Appellants did not persuasively rebut the Examiner's prima facie case of obviousness, but merely noted that the additional references fail to cure the previously-noted deficiencies in connection with claim 75. The rejection is therefore sustained.

DECISION

We have sustained the Examiner's rejections with respect to all claims on appeal. Therefore, the Examiner's decision rejecting claims 62-78 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2004).

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AFFIRMED

ARM

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